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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Vasulinga T. Ravikumar

Serial No.: 09/881,535

Filing Date: June 14, 2001

For: METHODS FOR PREPARING OLIGONUCLEOTIDES HAVING CHIRAL
PHOSPHOROTHIOATE LINKAGES

Confirmation No.: 8150

Group Art Unit: 1635

Examiner: Janet L. Epps

#12/K.T.
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REPLY

EXPRESS MAIL LABEL NO: EV160091134US
DATE OF DEPOSIT: March 28, 2003

Assistant Commissioner for Patents
Washington DC 20231

Sir:

REPLY PURSUANT TO 37 CFR § 1.111

This is in response to the Official Action dated December 31, 2002, issued in connection with the above-identified application. Reconsideration is respectfully requested in view of the following.

I. Rejection Under 35 U.S.C. § 103

Claims 1-16 and 33-36 stand rejected under 35 U.S.C. § 103(a) over the Cook et al. patent, U.S. Patent No. 6,440,943 ("the Cook patent") in view of the Barany et al. patent, U.S. Patent No. 5,852,168 ("the Barany patent") and the Eleuteri et al. patent, U.S. Patent No. 6,335,439 ("the Eleuteri patent"). Applicant respectfully traverses these rejections.

The present application has a filing date of June 14, 2001. Thus, the Cook patent

(issued August 27, 2002) and the Eleuteri patent (issued January 1, 2002), are only available as prior art to the instant application under 35 U.S.C. § 102(e).

Under the American Inventors Protection Action ("AIPA"), 35 U.S.C. § 103(c) provides that for applications filed after November 29, 1999, "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." In this regard, such subject matter cannot be applied in a rejection under 35 U.S.C. 103(a). This is further treated in M.P.E.P. 706.02.

As recorded in the Assignment Division of the USPTO on October 11, 2001 (Reel/Frame: 012251/0360, 3 pages), the present application is assigned in whole to ISIS Pharmaceuticals, Inc. A copy of the assignment is enclosed herewith for the Examiner's convenience. As shown on their faces, and recorded with the Assignment Division, the Cook patent (recorded at Reel/Frame: 010399/0289, 5 pages) and the Eleuteri patent (recorded at Reel/Frame: 9449/0621, 5 pages) were also assigned to ISIS Pharmaceuticals, Inc. Thus, it is evident that the Cook and Eleuteri patents, and the instant application were co-owned, as of the effective filing date of the instant application, by ISIS Pharmaceuticals, Inc.

Applicant respectfully submits that reference to the assignment documents as recorded in the patent office provides a sufficient showing under M.P.E.P. § 706.02(1)(2) to establish co-ownership at the time of invention, and thereby disqualifies the Cook and Eleuteri patents as prior art to the instant application for purposes of Section 103.

Applicant further respectfully submits that removal of the Cook patent as prior art

renders all of the Section 103 rejections moot, since that reference is the primary reference in each of the rejections. Moreover, the Eleuteri patent also may **not** be cited against the instant application under Section 103 (c), rendering rejections that additionally rely on this reference moot, as well. Accordingly, Applicant respectfully requests that the pending rejections under Section 103 be withdrawn.

Applicant respectfully submits that the Examiner should withdraw the outstanding rejections in the next office action, but if the Examiner makes new ground(s) for rejection, then the next action should be non-final. In this regard, Applicant notes that the enclosed Information Disclosure Statement (IDS) is being resubmitted at the request of the Examiner and should not be construed as Applicant's reply necessitating new ground(s) of rejection. The enclosed IDS is a second copy of the original IDS submitted July 20, 2001, which was apparently separated from the application file jacket.

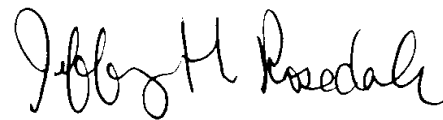
II. Conclusions

Applicant requests the Examiner to:

- (1) reconsider and withdraw the standing rejections of the claims;
- (2) consider the references cited in the re-submitted IDS enclosed herewith; and
- (3) pass claims 1-16 and 33-36 to allowance.

If the Examiner is of contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-5984.

Respectfully submitted,



Date: March 28, 2003

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